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EXAMINER
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NEGRON, ISMAEL

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/648,655

Applicant(s)

MUNARI, GENO

Examiner

Ismael Negron

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-12 and 14-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

### ***Response to Amendment***

2. Applicant's amendment filed on December 8, 2005 has been entered. Claims 1, 9 and 15 have been amended. Claims 6 and 13 have been cancelled. Claims 19-34 have been added. Claims 1-5, 7-12 and 14-34 are still pending in this application, with claims 1, 9, 15, 19 and 26 being independent.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5, 7-12, 14 and 19-30 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 is indefinite as it is not clear if the claimed subject matter is necessarily attached to a human finger or thumb (as implied by the recitation "*a portion of the emitted light is normal to the human finger or thumb*" in lines 8 and 9), or is merely the intended use of the claimed illumination device (as defined by the recitation "*for removably attaching said housing to a human finger of thumb*" in lines 6 and 7).
5. Claims 9, 19 and 26 are rejected for the same reasons as Claim 1 (see Section 4 above).
6. Claims 2-5, 7 and 8 are rejected for their dependency on rejected Claim 1.
7. Claims 10-12 and 14 are rejected for their dependency on rejected Claim 9.
8. Claims 20-25 are rejected for their dependency on rejected Claim 19.
9. Claims 27-30 are rejected for their dependency on rejected Claim 26.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 4, 8 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by GRAY (U.S. Pat. 5,653,524).

11. GRAY discloses an illumination device having:

- **a housing (as recited in Claim 1), Figure 1, reference number 10;**
- **a light source (as recited in Claim 1), Figure 5, reference number 54;**
- **the light source being located within the housing (as recited in Claim 1), as evidenced by Figure 4;**
- **a power source (as recited in Claim 1), Figure 3, reference number 25;**
- **the power source being located within the housing (as recited in Claim 1), as seen in Figure 3;**
- **means for intermittently activating the light source (as recited in Claim 1), Figure 5, reference number 56;**
- **a resilient strap (as recited in Claim 1), Figure 1, reference number 14;**
- **the resilient strap being for removably attaching the housing to a human finger (as recited in Claim 1), inherent;**
- **a portion of emitted light being normal to the finger when activated (as recited in Claim 1), inherent as evidenced by Figure 1;**

- **the light source being a light emitting diode (as recited in Claim 2), column 4, line 48;**
- **the means for intermittently activating the light source including a button (as recited in Claim 4), Figure 2, reference number 52;**
- **the light source being activated by applying pressure to the button (as recited in Claim 4), column 5, lines 6-8;**
- **the button being exposed near a first end of the housing (as recited in Claim 4), as seen in Figure 2;**
- **the light source being activated as long as pressure is applied to the button (as recited in Claim 4), column 5, lines 6-8; and**
- **the housing being translucent (as recited in Claim 8), column 4, lines 28-31.**

12. Method claims 15-17 were considered as inherently disclosed by the patented structure of GRAY, as detailed in Section 11 above.

13. Claims 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by GRAY (U.S. Pat. 5,653,524).

14. GRAY discloses an illumination device having:

- **a housing (as recited in Claim 9), Figure 1, reference number 10;**

- **a light source (as recited in Claim 9), Figure 5, reference number 54;**
- **the light source being located within the housing (as recited in Claim 9), as evidenced by Figure 4;**
- **a power source (as recited in Claim 9), Figure 3, reference number 25;**
- **the power source being located within the housing (as recited in Claim 9), as seen in Figure 3;**
- **a button (as recited in Claim 9), Figure 2, reference number 52;**
- **the button being located near one end of the housing (as recited in Claim 9), as seen in Figure 2;**
- **the light source being activated by applying pressure to the button (as recited in Claim 9), column 5, lines 6-8;**
- **a resilient strap (as recited in Claim 9), Figure 1, reference number 14;**
- **the resilient strap being for removably attaching the housing to a human finger (as recited in Claim 9), inherent;**
- **a portion of emitted light being normal to the finger when activated (as recited in Claim 9), inherent as evidenced by Figure 1; and**
- **the light source being a light emitting diode (as recited in Claim 10), column 4, line 48.**

15. Claims 19, 20, 22, 25 and 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by GONG-HWA (U.S. Pat. 5,622,062).

16. GONG-HWA discloses an illumination device having:

- **a housing (as recited in Claim 19), Figure 2, reference number 10;**
- **a light source (as recited in Claim 19), Figure 2, reference number 30;**
- **the light source being located within the housing (as recited in Claim 19), as seen in Figure 2;**
- **a power source (as recited in Claim 19), Figure 2, reference number 33;**
- **the power source being located within the housing (as recited in Claim 19), as seen in Figure 2;**
- **means for intermittently activating the light source (as recited in Claim 19), Figure 2, reference number 30;**
- **two or more flexible members (as recited in Claim 19), Figure 2, reference number 11;**
- **the flexible members being for removably attaching the housing to a human finger (as recited in Claim 19), column 1, lines 64-66;**



- **a portion of emitted light being normal to the finger when activated (as recited in Claim 19), inherent as evidenced by Figure 1;**
- **the light source being a light emitting diode (as recited in Claim 20), column 2, line 8 and 9;**
- **the means for intermittently activating the light source including a button (as recited in Claim 22), Figure 3, reference characters SW1;**
- **the light source being activated by applying pressure to the button (as recited in Claim 22), column 2, lines 18-24;**
- **the button being exposed near a first end of the housing (as recited in Claim 22), as evidenced by column 2, lines 27-30;**
- **the light source being activated as long as pressure is applied to the button (as recited in Claim 22), column 2, 18-24; and**
- **the housing being translucent (as recited in Claim 25), as evidenced by column 2, lines 33-35.**

17. Method claims 31-33 were considered as inherently disclosed by the patented structure of GONG-HWA, as detailed in Section 16 above.

18. Claims 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by GONG-HWA (U.S. Pat. 5,622,062).

19. GONG-HWA discloses an illumination device having:

- **a housing (as recited in Claim 26), Figure 2, reference number 10;**
- **a light source (as recited in Claim 26), Figure 2, reference number 30;**
- **the light source being located within the housing (as recited in Claim 26), as seen in Figure 2;**
- **a power source (as recited in Claim 26), Figure 2, reference number 33;**
- **the power source being located within the housing (as recited in Claim 26), as seen in Figure 2;**
- **a button (as recited in Claim 26), Figure 3, reference characters SW1;**
- **the button being located near one end of the housing (as recited in Claim 26), as evidenced by column 2, lines 27-30;**
- **the light source being activated by applying pressure to the button (as recited in Claim 26), column 2, lines 18-24;**
- **two or more flexible members (as recited in Claim 26), Figure 2, reference number 11;**
- **the flexible members being for removably attaching the housing to a human finger (as recited in Claim 26), column 1, lines 64-66;**

- **a portion of emitted light being normal to the finger when activated (as recited in Claim 26), inherent as evidenced by Figure 1; and**
- **the light source being a light emitting diode (as recited in Claim 27), column 2, line 8 and 9.**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 3, 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over GRAY (U.S. Pat. 5,653,524).

21. GRAY discloses an illumination device having:

- **a housing (as recited in Claim 1), Figure 1, reference number 10;**
- **a light source (as recited in Claim 1), Figure 5, reference number 54;**
- **the light source being located within the housing (as recited in Claim 1), as evidenced by Figure 4;**

- **a power source (as recited in Claim 1), Figure 3, reference number 25;**
- **the power source being located within the housing (as recited in Claim 1), as seen in Figure 3;**
- **means for intermittently activating the light source (as recited in Claim 1), Figure 5, reference number 56;**
- **a resilient strap (as recited in Claim 1), Figure 1, reference number 14;**
- **the resilient strap being for removably attaching the housing to a human finger (as recited in Claim 1), inherent; and**
- **a portion of emitted light being normal to the finger when activated (as recited in Claim 1), inherent as evidenced by Figure 1.**

22. GRAY discloses all the limitations of the claims, except the battery being a lithium battery (as recited in Claim 3), or a flesh-colored sheath for covering the housing (as recited in Claim 7).

23. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use a lithium battery (as recited in Claim 3) as the battery disclosed by GRAY, since the Examiner takes Official Notice that the use of lithium batteries is old and well known in the illumination art. One would have been

motivated since lithium batteries are recognized to have many desirable advantages, including reduced size, high efficiency, and high power production, over other batteries.

24. Regarding Claim 7, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include a flesh-colored sheath for covering the housing of GRAY (as recited in Claim 7), since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In this case, one would have been motivated to include the claimed flesh-colored sheath to obtain a flesh colored device, as necessitated by the specific aesthetic requirements of a particular application.

25. Method Claim 18 was considered as inherently disclosed, or suggested, by the patented structure of GRAY (as detailed in Sections 21-24 above).

26. Claim 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over GRAY (U.S. Pat. 5,653,524).

27. GRAY discloses an illumination device having:

- **a housing (as recited in Claim 9)**, Figure 1, reference number 10;
- **a light source (as recited in Claim 9)**, Figure 5, reference number 54;

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- **the light source being located within the housing (as recited in Claim 9), as evidenced by Figure 4;**
- **a power source (as recited in Claim 9), Figure 3, reference number 25;**
- **the power source being located within the housing (as recited in Claim 9), as seen in Figure 3;**
- **a button (as recited in Claim 9), Figure 2, reference number 52;**
- **the button being located near one end of the housing (as recited in Claim 9), as seen in Figure 2;**
- **the light source being activated by applying pressure to the button (as recited in Claim 9), column 5, lines 6-8;**
- **a resilient strap (as recited in Claim 9), Figure 1, reference number 14;**
- **the resilient strap being for removably attaching the housing to a human finger (as recited in Claim 9), inherent; and**
- **a portion of emitted light being normal to the finger when activated (as recited in Claim 9), inherent as evidenced by Figure 1.**

28. GRAY discloses all the limitations of the claims, except the battery being a lithium battery (as recited in Claim 11), or a flesh-colored sheath for covering the housing (as recited in Claim 14).

29. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use a lithium battery (as recited in Claim 11) as the battery disclosed by GRAY, since the Examiner takes Official Notice that the use of lithium batteries is old and well known in the illumination art. One would have been motivated since lithium batteries are recognized to have many desirable advantages, including reduced size, high efficiency, and high power production, over other batteries.

30. Regarding Claim 14, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include a flesh-colored sheath for covering the housing of GRAY (as recited in Claim 14), since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In this case, one would have been motivated to include the claimed flesh-colored sheath to obtain a flesh colored device, as necessitated by the specific aesthetic requirements of a particular application.

31. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over GRAY (U.S. Pat. 5,653,524) in view of DION (U.S. Pat. 5,934,784).

32. GRAY discloses an illumination device having:

- **a housing (as recited in Claim 1), Figure 1, reference number 10;**

- **a light source (as recited in Claim 1), Figure 5, reference number 54;**
- **the light source being located within the housing (as recited in Claim 1), as evidenced by Figure 4;**
- **a power source (as recited in Claim 1), Figure 3, reference number 25;**
- **the power source being located within the housing (as recited in Claim 1), as seen in Figure 3;**
- **means for intermittently activating the light source (as recited in Claim 1), Figure 5, reference number 56;**
- **a resilient strap (as recited in Claim 1), Figure 1, reference number 14;**
- **the resilient strap being for removably attaching the housing to a human finger (as recited in Claim 1), inherent; and**
- **a portion of emitted light being normal to the finger when activated (as recited in Claim 1), inherent as evidenced by Figure 1.**

33. GRAY discloses all the limitations of the claims, except the resilient strap being elastic (as recited in Claim 5).

34. DION discloses an illumination device having:

- **a housing (as recited in Claim 1), Figure 1, reference number 10;**



- **a light source (as recited in Claim 1), Figure 1, reference number 34;**
- **the light source being located within the housing (as recited in Claim 1), as seen in Figure 1;**
- **a power source (as recited in Claim 1), Figure 1, reference number 26;**
- **the power source being located within the housing (as recited in Claim 1), as seen in Figure 1;**
- **means for intermittently activating the light source (as recited in Claim 1), Figure 2, reference number 38;**
- **a resilient strap (as recited in Claim 1), Figure 1, reference number 16; and**
- **the resilient strap being elastic (as recited in Claim 5), column2, line 55.**

35. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to replace the resilient strap of GRAY with the elastic strap of DION to enable the patented device of GARY to be removably attached to a plurality of members of a plurality of different sizes and shapes, as evidenced by DION.

36. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over GRAY (U.S. Pat. 5,653,524) in view of DION (U.S. Pat. 5,934,784).

37. GRAY discloses an illumination device having:

- **a housing (as recited in Claim 9), Figure 1, reference number 10;**
- **a light source (as recited in Claim 9), Figure 5, reference number 54;**
- **the light source being located within the housing (as recited in Claim 9), as evidenced by Figure 4;**
- **a power source (as recited in Claim 9), Figure 3, reference number 25;**
- **the power source being located within the housing (as recited in Claim 9), as seen in Figure 3;**
- **a button (as recited in Claim 9), Figure 2, reference number 52;**
- **the button being located near one end of the housing (as recited in Claim 9), as seen in Figure 2;**
- **the light source being activated by applying pressure to the button (as recited in Claim 9), column 5, lines 6-8;**
- **a resilient strap (as recited in Claim 9), Figure 1, reference number 14;**
- **the resilient strap being for removably attaching the housing to a human finger (as recited in Claim 9), inherent; and**
- **a portion of emitted light being normal to the finger when activated (as recited in Claim 9), inherent as evidenced by Figure 1.**

38. GRAY discloses all the limitations of the claims, except the resilient strap being elastic (as recited in Claim 12).

39. DION discloses an illumination device having:

- **a housing (as recited in Claim 9), Figure 1, reference number 10;**
- **a light source (as recited in Claim 9), Figure 1, reference number 34;**
- **the light source being located within the housing (as recited in Claim 9), as seen in Figure 1;**
- **a power source (as recited in Claim 9), Figure 1, reference number 26;**
- **the power source being located within the housing (as recited in Claim 9), as seen in Figure 1;**
- **means for intermittently activating the light source (as recited in Claim 9), Figure 2, reference number 38;**
- **a resilient strap (as recited in Claim 9), Figure 1, reference number 16; and**
- **the resilient strap being elastic (as recited in Claim 12), column2, line 55.**

40. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to replace the resilient strap of GRAY with the elastic strap

of DION to enable the patented device of GARY to be removably attached to a plurality of members of a plurality of different sizes and shapes, as evidenced by DION.

41. Claims 21, 24 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over GONG-HWA (U.S. Pat. 5,622,062).

42. GONG-HWA discloses an illumination device having:

- **a housing (as recited in Claim 19), Figure 2, reference number 10;**
- **a light source (as recited in Claim 19), Figure 2, reference number 30;**
- **the light source being located within the housing (as recited in Claim 19), as seen in Figure 2;**
- **a power source (as recited in Claim 19), Figure 2, reference number 33;**
- **the power source being located within the housing (as recited in Claim 19), as seen in Figure 2;**
- **means for intermittently activating the light source (as recited in Claim 19), Figure 2, reference number 30;**
- **two or more flexible members (as recited in Claim 19), Figure 2, reference number 11;**

- **the flexible members being for removably attaching the housing to a human finger (as recited in Claim 19)**, column 1, lines 64-66; and
- **a portion of emitted light being normal to the finger when activated (as recited in Claim 19)**, inherent as evidenced by Figure 1.

43. GONG-HWA discloses all the limitations of the claims, except the battery being a lithium battery (as recited in Claim 21), or a flesh-colored sheath for covering the housing (as recited in Claim 24).

44. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use a lithium battery (as recited in Claim 21) as the battery disclosed by GONG-HWA, since the Examiner takes Official Notice that the use of lithium batteries is old and well known in the illumination art. One would have been motivated since lithium batteries are recognized to have many desirable advantages, including reduced size, high efficiency, and high power production, over other batteries.

45. Regarding Claim 24, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include a flesh-colored sheath for covering the housing of GONG-HWA (as recited in Claim 24), since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In this case, one would have

been motivated to include the claimed flesh-colored sheath to obtain a flesh colored device, as necessitated by the specific aesthetic requirements of a particular application.

46. Method Claim 34 was considered as inherently disclosed, or suggested, by the patented structure of GRAY (as detailed in Sections 42-45 above).

47. Claims 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over GONG-HWA (U.S. Pat. 5,622,062).

48. GONG-HWA discloses an illumination device having:

- **a housing (as recited in Claim 26)**, Figure 2, reference number 10;
- **a light source (as recited in Claim 26)**, Figure 2, reference number 30;
- **the light source being located within the housing (as recited in Claim 26)**, as seen in Figure 2;
- **a power source (as recited in Claim 26)**, Figure 2, reference number 33;
- **the power source being located within the housing (as recited in Claim 26)**, as seen in Figure 2;

- **a button (as recited in Claim 26), Figure 3, reference characters SW1;**
- **the button being located near one end of the housing (as recited in Claim 26), as evidenced by column 2, lines 27-30;**
- **the light source being activated by applying pressure to the button (as recited in Claim 26), column 2, lines 18-24;**
- **two or more flexible members (as recited in Claim 26), Figure 2, reference number 11;**
- **the flexible members being for removably attaching the housing to a human finger (as recited in Claim 26), column 1, lines 64-66; and**
- **a portion of emitted light being normal to the finger when activated (as recited in Claim 26), inherent as evidenced by Figure 1.**

49. GONG-HWA discloses all the limitations of the claims, except the battery being a lithium battery (as recited in Claim 28), or a flesh-colored sheath for covering the housing (as recited in Claim 30).

50. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use a lithium battery (as recited in Claim 28) as the battery disclosed by GONG-HWA, since the Examiner takes Official Notice that the use of lithium batteries is old and well known in the illumination art. One would have been

motivated since lithium batteries are recognized to have many desirable advantages, including reduced size, high efficiency, and high power production, over other batteries.

51. Regarding Claim 30, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include a flesh-colored sheath for covering the housing of GONG-HWA (as recited in Claim 30), since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In this case, one would have been motivated to include the claimed flesh-colored sheath to obtain a flesh colored device, as necessitated by the specific aesthetic requirements of a particular application.

52. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over GONG-HWA (U.S. Pat. 5,622,062).

53. GONG-HWA discloses an illumination device having:

- **a housing (as recited in Claim 19)**, Figure 2, reference number 10;
- **a light source (as recited in Claim 19)**, Figure 2, reference number 30;
- **the light source being located within the housing (as recited in Claim 19)**, as seen in Figure 2;



- **a power source (as recited in Claim 19), Figure 2, reference number 33;**
- **the power source being located within the housing (as recited in Claim 19), as seen in Figure 2;**
- **means for intermittently activating the light source (as recited in Claim 19), Figure 2, reference number 30;**
- **two or more flexible members (as recited in Claim 19), Figure 2, reference number 11;**
- **the flexible members being for removably attaching the housing to a human finger (as recited in Claim 19), column 1, lines 64-66; and**
- **a portion of emitted light being normal to the finger when activated (as recited in Claim 19), inherent as evidenced by Figure 1.**

54. GONG-HWA discloses all the limitations of the claims, except the flexible members being metallic (as recited in Claim 23).

55. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use a metallic material for the flexible members of GONG-HWA (as recited in Claim 23), since it has been held by the courts that selection of a prior art material on the basis of its suitability for its intended purpose is within the level of ordinary skill. *In re Leshing*, 125 USPQ 416 (CCPA 1960) and *Sinclair &*

*Carroll Co. v. Interchemical Corp.*, 65 USPQ 297 (1945). In this case, any resilient material could be used to attached the device to a support structure, as admitted by the applicant (see paragraph 0015, lines 6 and 7 of the specification as originally filed).

56. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over GONG-HWA (U.S. Pat. 5,622,062).

57. GONG-HWA discloses an illumination device having:

- **a housing (as recited in Claim 26)**, Figure 2, reference number 10;
- **a light source (as recited in Claim 26)**, Figure 2, reference number 30;
- **the light source being located within the housing (as recited in Claim 26)**, as seen in Figure 2;
- **a power source (as recited in Claim 26)**, Figure 2, reference number 33;
- **the power source being located within the housing (as recited in Claim 26)**, as seen in Figure 2;
- **a button (as recited in Claim 26)**, Figure 3, reference characters SW1;
- **the button being located near one end of the housing (as recited in Claim 26)**, as evidenced by column 2, lines 27-30;

- **the light source being activated by applying pressure to the button (as recited in Claim 26),** column 2, lines 18-24;
- **two or more flexible members (as recited in Claim 26),** Figure 2, reference number 11;
- **the flexible members being for removably attaching the housing to a human finger (as recited in Claim 26),** column 1, lines 64-66; and
- **a portion of emitted light being normal to the finger when activated (as recited in Claim 26),** inherent as evidenced by Figure 1.

58. GONG-HWA discloses all the limitations of the claims, except the flexible members being metallic (as recited in Claim 29).

59. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use a metallic material for the flexible members of GONG-HWA (as recited in Claim 29), since it has been held by the courts that selection of a prior art material on the basis of its suitability for its intended purpose is within the level of ordinary skill. *In re Leshing*, 125 USPQ 416 (CCPA 1960) and *Sinclair & Carroll Co. v. Interchemical Corp.*, 65 USPQ 297 (1945). In this case, any resilient material could be used to attached the device to a support structure, as admitted by the applicant (see paragraph 0015, lines 6 and 7 of the specification as originally filed).

***Response to Arguments***

60. Applicant's arguments with respect to claims 1-20 (filed December 8, 2005) have been considered but are moot in view of the new ground(s) of rejection.

61. Regarding the Examiner's Official Notice of the use of lithium batteries being old and well known in the illumination art (originally presented in Section 7 of the Office Action mailed February 25, 2005, and later in Section 12 of the Final Office Action mailed August 16, 2005), the applicant is advised that applicant's failure to traverse such Official Notice has been taken as an admission that such limitation is indeed Prior Art. See MPEP 2144.03(c) and 37 C.F.R. 1.111(b).

***Relevant Prior Art***

62. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

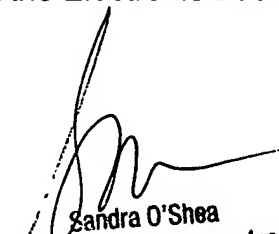
**Prahar** (U.S. Pat. 1,307,456), **Simms** (U.S. Pat. 4,012,629), **Roman** (U.S. Pat. 3,392,276), **Vaagenes** (U.S. Pat. 4,093,973), **Oberlander** (U.S. Pat. 5,193,896), **Fromm** (U.S. Pat. 6,050,695), **Naghi et al.** (U.S. Pat. Pub. NO. 2002/0131266), **Gobbell** (U.S. Pat. 6,663,256) and **Granite** (U.S. Pat. 6,540,369) disclose illumination devices having a housing containing a light source and a power source, such housing including means capable of attaching the housing to a finger such that light emitted from the light source projects normal to the finger.

***Conclusion***

63. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (571) 273-8300.

64. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



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